

# **Procedures to file a request to the Swedish Patent and Registration Office (PRV) under the Patent Prosecution Highway (PPH) Pilot Program between the National Institute of Industrial Property of Brazil (INPI) and PRV**

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## **Overview of the PPH procedure**

An applicant, who has filed an application to INPI under this PPH pilot program may, when filing a corresponding application to the PRV, request accelerated examination by submitting a request form, accompanied by supporting documents. The application must satisfy certain requirements as set out below.

The PRV decides whether the application can be entitled the status of accelerated examination under the PPH when PRV receives a request with the documents stated above. When PRV decides that a request is acceptable, the applicant will be notified and the application is assigned a special status for accelerated examination.

If the request does not meet all the requirements set forth below, the applicant will be notified and the defects in the request will be identified. The applicant will be given opportunity to correct the request. If the defect(s) are not corrected, the application will await action in its regular turn.

The Offices may terminate the PPH pilot program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated.

# **Part I - PPH using national (Paris convention) work products**

When filing a request for the PPH pilot program, an applicant must submit a request form accompanied by the relevant supporting documents. The requirements for an application to the PRV for accelerated examination under the PPH are given in section 1 and relevant supporting documentation is discussed in section 2.

## **1. Requirements**

The application which is filed with the PRV and on which the applicant files a request under the PPH must satisfy the following requirements:

**1.1 Both the PRV application on which PPH is requested and the INPI application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).**

For example, the PRV application (including PCT national phase application) may be either:

(Case I) - an application which validly claims priority under the Paris Convention from the INPI application(s) (examples are provided in Annex 2, Figures A, B, C, H, I and J), or

(Case II) - an application which provides the basis of a valid priority claim under the Paris Convention for the INPI application(s) (including PCT national phase application(s)) (examples are provided in Annex 2, Figures D and E), or

(Case III) - an application which shares a common priority document with the INPI application(s) (including PCT national phase application(s)) (examples are provided in Annex 2, Figures F, G, L, M and N), or

(Case IV) - a PCT national phase application where both the PRV application and the INPI application(s) are derived from a common PCT international application having no priority claim (an example is provided in Annex 2, Figure K).

**1.2 At least one corresponding application exists in the INPI and has one or more claims that are determined to be patentable/allowable by the INPI.**

**1.3 All claims in the PRV application (for which an accelerated examination under the PPH pilot program is requested) must sufficiently correspond to one or more of those claims determined to be patentable/allowable in the INPI.**

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the PRV are of the same or similar scope as the claims in the INPI, or the claims in the PRV are narrower in scope than the claims in the INPI. In this regard, a claim that is narrower in scope occurs when an INPI claim is amended to be further limited by an additional technical feature that is supported in the specification (description and/or claims). A claim in the PRV application which introduces a new/different category of claims to those claims indicated as allowable in the INPI is not considered to sufficiently correspond. For example, where the INPI claims only contain claims to a process of manufacturing a product, then the claims in the PRV are not considered to sufficiently correspond if the PRV application claims introduce product claims that are dependent on the corresponding process claims. Any claims amended or added after the grant of the request for participation in the PPH pilot program need not to sufficiently correspond to the claims indicated as patentable/allowable in the INPI application.

**1.4 The PRV has not yet issued a “Final notice” (Swedish: “Slutföreläggande”) at the time of request under PPH**

## **2. Documents to be submitted**

Documents (a) to (d) below must be submitted by attaching to the PPH request.

All documents under this paragraph with exception for the cited documents have to be drawn up in or translated to Swedish or English. Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated work product or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

**(a) Copies of all Office actions (which are relevant to substantial examination for patentability in the INPI) which were issued for the corresponding application by the INPI, and translations of them.**

PRV accepts any substantive search and examination product that explicitly indicates the patentability of claims (e.g. those including a written opinion if other than an initial notice to grant) done by the INPI under any filing scenario (e.g. as a National Office under the Paris Convention or as an ISA/IPEA office under the PCT).

The applicant does not have to submit a copy of INPI Office actions and translations of them when those documents can be provided via the INPI's dossier access system. If they cannot be obtained by the PRV examiner via the INPI's dossier access system, the applicant may be notified and requested to provide the necessary documents.

**(b) Copies of all claims determined to be patentable/allowable by the INPI, and translations of them.**

The applicant does not have to submit a copy of claims indicated to be patentable/allowable in the INPI, and translations thereof when the documents are provided via the INPI's dossier access system. If they cannot be obtained by the PRV examiner via the INPI's dossier access system, the applicant may be notified and requested to provide the necessary documents.

**(c) Copies of references cited by the INPI examiner**

If the references are patent documents, the applicant doesn't have to submit them because the PRV usually possesses them. When the PRV does not possess the patent document, the applicant has to submit the patent document at the examiner's request. Non-patent literature must always be submitted. Translations of the references are unnecessary.

**(d) Claim correspondence table**

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the PRV application sufficiently correspond to the patentable/allowable claims in the INPI application.

When claims are just literal translation, the applicant can just write down that "they are the same" in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim.

When the applicant has already submitted above documents (a) to (d) to the PRV through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

# **Part II - PPH Using Patent Cooperation Treaty (PCT) Work**

## **Products**

When filing a request for the PCT-PPH pilot program, an applicant must submit a request form, accompanied by the relevant supporting documents. The requirements for accelerated examination under the PCT-PPH are given in section 1 below and relevant supporting documentation is discussed in section 2.

If the request concerns a national continuation of an international application (See Figures A, A', and A'' in Annex 3) where all formal requirements are fulfilled, the request is regarded as an indication from the applicant to permit PRV to immediately launch the search and examination work in the application concerned (cf. Swedish Patent Act, 33, 34§§ and Swedish Patent Decree, 58§ ). No further indication from the applicant is necessary.

### **1. Requirements**

The application which is filed with the PRV and on which the applicant files a request under the PCT-PPH must satisfy the following requirements 1.1 – 1.4:

**1.1 The latest work product in the international phase of a PCT application corresponding to the application namely the Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examination Authority (WO/IPEA), the International Preliminary Report on Patentability (IPRP) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/allowable (from the aspects of novelty, inventive step and industrial applicability).**

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA, IPRP and the IPER are limited to the INPI, but, if priority is claimed, the priority claim can be to an application in any Office, see example A' in Annex 4 (application ZZ can be any national application). The applicant cannot file a request under PCT-PPH on the basis of an International Search Report (ISR) only.

In case any observation is described in Box VIII of WO/ISA, WO/IPEA, IPRP or IPER which forms the basis of a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation irrespective of whether or not an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in PCT-PPH pilot program if the applicant does

not explain why the claim(s) is/are not subject to the observation. In this regard, however, it does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted in Box VIII.

**1.2 The relationship between the application and the corresponding international application satisfies one of the following requirements (including the case where the Office of the application is the same as the ISA/IPEA of the corresponding international application):**

- A. The application is a national phase application of the corresponding international application. (See Figures A, A', and A'' in Annex 3)
- B. The application is a national application which provides the basis of a valid priority claim of the corresponding international application. (See Figure B in Annex 3)
- C. The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex 3)
- D. The application is a national application claiming foreign/domestic priority from the corresponding international application. (See Figure D in Annex 3)
- E. The application is an application derived (divisional application and application claiming domestic priority etc.) from an application which satisfies one of the above requirements (A) – (D). (See Figures E1 and E2 in Annex 3)

**1.3 All claims on file, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated to be patentable/allowable in the latest international work product of the corresponding international application.**

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims of the application are of the same or similar scope as the claims indicated to be patentable/allowable in the latest international work product, or the claims of the application are narrower in scope than the claims indicated to be patentable/allowable in the latest international work product.

In this regard, a claim that is narrower in scope occurs when a claim indicated to be patentable/allowable in the latest international work product is amended to be further limited by an additional feature that is supported in the specification (description and/or claims) of the application.

A claim of the application which introduces a new/different category of claims to those claims indicated to be patentable/allowable in the latest international work product is not considered to sufficiently correspond. For example, the claims indicated to be patentable/allowable in the latest international work product only contain claims to a process of manufacturing a product, then the claims of the application are not considered to sufficiently correspond if the claims of the application introduce product claims that are dependent on the corresponding process claims.

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program need not to sufficiently correspond to the claims indicated as patentable/allowable in the latest international work product.

#### **1.4 PRV has not yet issued a “Final notice” (Swedish: Slutföreläggande) at the time of request under PCT-PPH**

## **2. Documents to be submitted**

The applicant must submit the following documents (a) – (d) attached to the request form when filing a request under PCT-PPH. All documents under this paragraph with exception for the cited documents have to be drawn up in or translated to Swedish or English. Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated work product or claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

### **(a) A copy of the latest international work product of the corresponding international application**

In case the application satisfies the relationship (A)(See Annex 3) the applicant does not need to submit a copy of the latest International work product, because a copy of this document is already available in the file-wrapper of the application. In addition, if the copy of the latest international work product is available via WIPOs database PATENTSCOPE®, an applicant does not need to submit these documents, unless otherwise requested by the PRV (WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively after 30 months from the priority date.)

### **(b) A copy of a set of claims which the latest international work product of the corresponding international application indicated as allowable**

If the copy of the set of claims which are indicated as allowable is available via WIPOs database PATENTSCOPE® (or the international Patent Gazette has been published), an



applicant does not need to submit this document, unless otherwise requested by the PRV. Where translations of the allowable claims are necessary, they must be submitted by the applicant since PATENTSCOPE® does not provide them.

**(c) Copies of references cited in the latest international work product of the corresponding international application**

If the references are patent documents, the applicant does not have to submit them because the Office of the application usually has access to them. When the Office of the application does not have access to the patent document, the applicant has to submit the patent document at the examiner's request. Non-patent literature must always be submitted. Submission of translation of the references is not required. However, applicants will be free to file translations as part of the supporting documentation when initially requesting accelerated examination under the PCT-PPH to allow prompt consideration of the citations if the applicants so desire.

**(d) Claim correspondence table**

The applicant must submit a claim correspondence table to explain the correspondence of claims determined to be allowable in the latest work product of the corresponding international application and all claims in the application (See Annex 1).

In case the applicant has already submitted the documents mentioned above in paragraphs 2.1 – 2.4 to the PRV through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

## Annex 1

### Examples for the claim correspondence table

The claims in the following cases are considered to “sufficiently correspond”.

#### EX.1

<i>Claims in the INPI</i>	<i>PRV claims</i>	<i>Comment</i>
1	1	<i>The PRV claim has the additional component on the claim that is determined to be patentable in the PCT application.</i>

#### EX.2

Allowable claim, INPI.	PRV claim
<p>A system for presenting a container storing at least one article to a processing tool, comprising:</p> <p>(a) a load port, including:</p> <p style="padding-left: 20px;">a frame having an opening;</p> <p style="padding-left: 20px;">a support structure being adapted to receive a container, and</p> <p style="padding-left: 20px;">a drive mechanism for moving said support structure substantially vertically between a first height and a second height; and</p> <p>(b) a conveyor for movably supporting the container substantially along a container transport plane;</p> <p style="padding-left: 20px;">wherein a container traveling on said conveyer moves unobstructed over said support structure when said support structure is located in said second height,</p> <p style="padding-left: 20px;">wherein the container traveling unobstructed does not contact said support structure while traveling over said support structure located at said second height,</p> <p style="padding-left: 20px;">wherein said support structure, when located at said second height, is located below said transport plane.</p> <p><i>*This additional part is NOT included in the allowable claim but it is included in the description of the national application</i></p>	<p>A system for presenting a container storing at least one article to a processing tool, comprising:</p> <p>(a) a load port, including:</p> <p style="padding-left: 20px;">a frame having an opening;</p> <p style="padding-left: 20px;">a support structure being adapted to receive a container, and</p> <p style="padding-left: 20px;">a drive mechanism for moving said support structure substantially vertically between a first height and a second height; and</p> <p>(b) a conveyor for movably supporting the container substantially along a container transport plane;</p> <p style="padding-left: 20px;">wherein a container traveling on said conveyer moves unobstructed over said support structure when said support structure is located in said second height,</p> <p style="padding-left: 20px;">wherein the container traveling unobstructed does not contact said support structure while traveling over said support structure located at said second height,</p> <p style="padding-left: 20px;">wherein said support structure, when located at said second height, is located below said transport plane,</p> <p style="padding-left: 20px;"><b><u>wherein said support structure, when located at said first height, is located above said transport plane*</u></b></p>

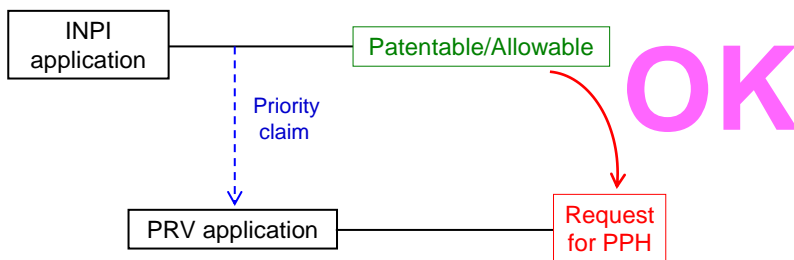
<i>Claims in the INPI</i>	<i>PRV claims</i>	<i>Comment</i>
1	1	Same
none	2	<i>The PRV claim2 is dependent on the PRV claim1, which has been determined to be patentable in the PCT application.</i>

Allowable claim, INPI	PRV claim
1. A nitride-based semiconductor device comprising: a first semiconductor layer, consisting of either an n type nitride-based semiconductor layer having awurtzite structure or an n-type nitride-based semiconductor substrate having awurtzite structure; and an n-side electrode formed on a back surface of said first semiconductor layer, wherein a dislocation density is not more than $1 \cdot 10^8 \text{ cm}^{-2}$ in the vicinity of the interface between said first semiconductor layer and said nside electrode, and contact resistance between said nside electrode and said first semiconductor layer is not more than $0.05 \text{ } \Omega \text{ cm}^2$	1. (Same)
2. (None)	<b>2. The nitride-based semiconductor device according to claim 1, wherein said first semiconductor layer includes an ntype dopant*</b>

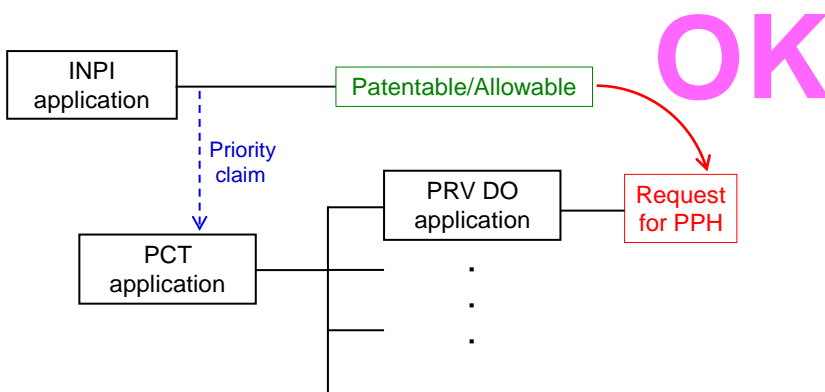
\* This additional part is NOT included in the allowable claim  
but it is included in the description of the national application

## Annex 2

**A** A case meeting requirement (a) (I)  
- Paris route -



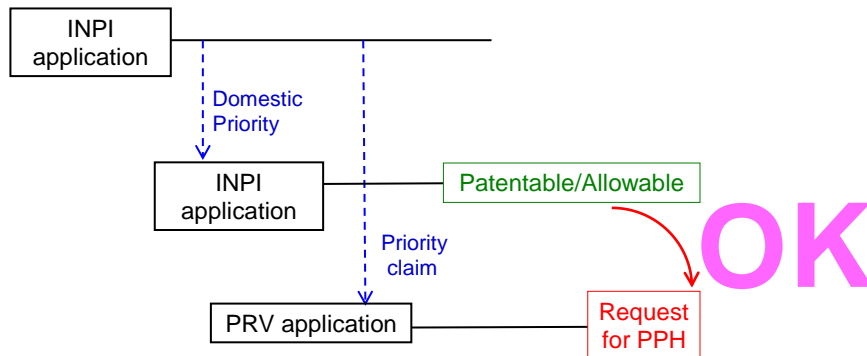
**B** A case meeting requirement (a) (I)  
- PCT route -



C

### A case meeting requirement (a) (I)

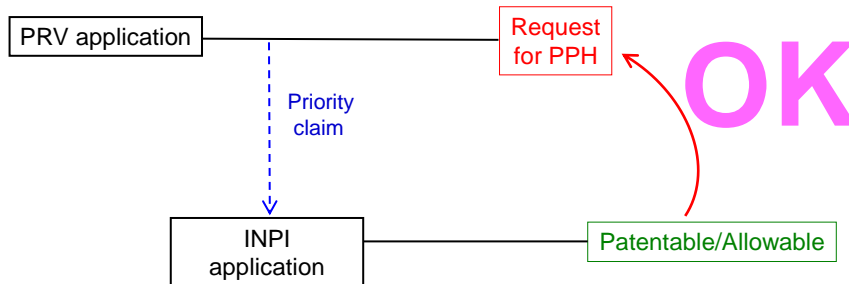
- PCT route, Domestic priority -



D

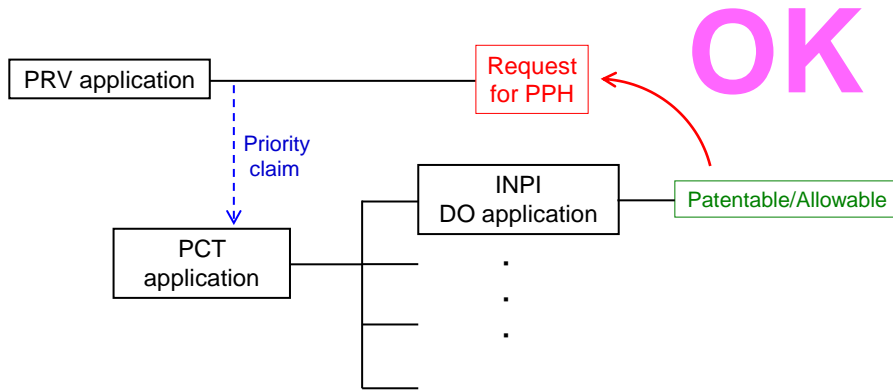
### A case meeting requirement (a) (II)

- Paris route -



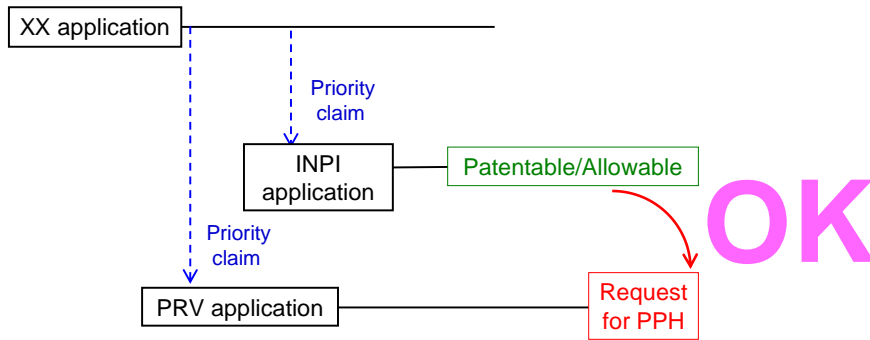
E

### A case meeting requirement (a) (II) - PCT route -



F

### A case meeting requirement (a) (III) - Paris route, but the first application is from the third country -

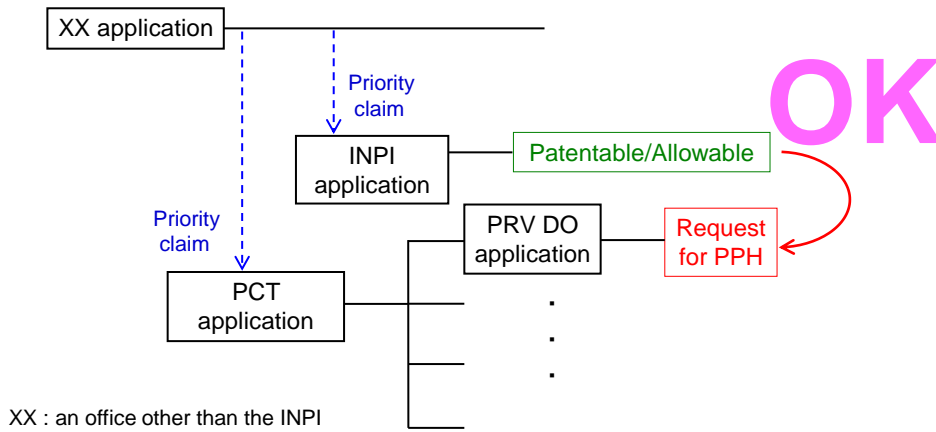


XX : an office other than the INPI

G

### A case meeting requirement (a) (III)

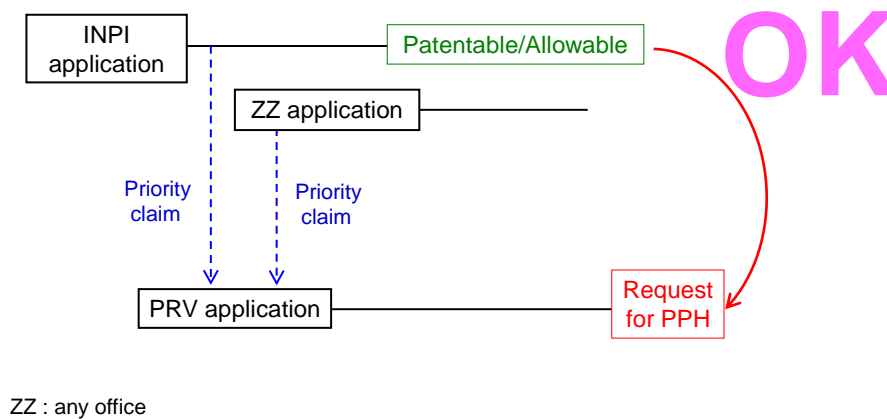
- PCT route, but the first application is from the third country -



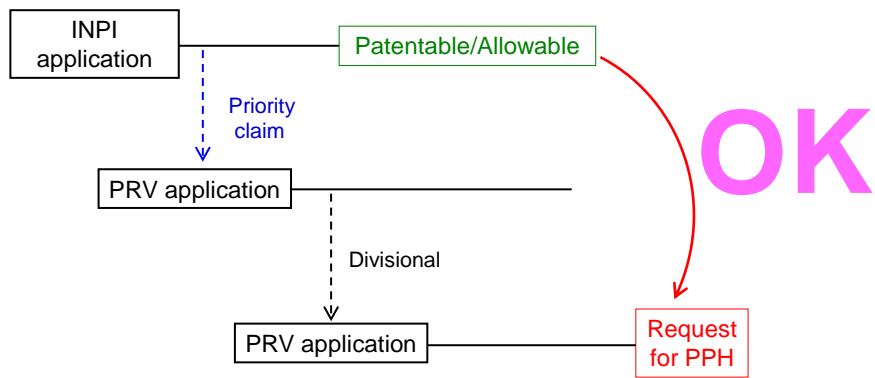
H

### A case meeting requirement (a) (I)

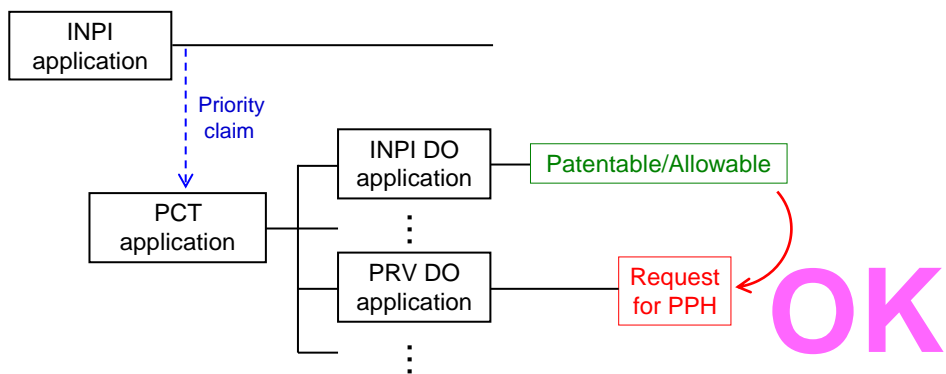
- Paris route & Complex priority -



**I** A case meeting requirement (a) (I)  
 - Paris route & divisional application -

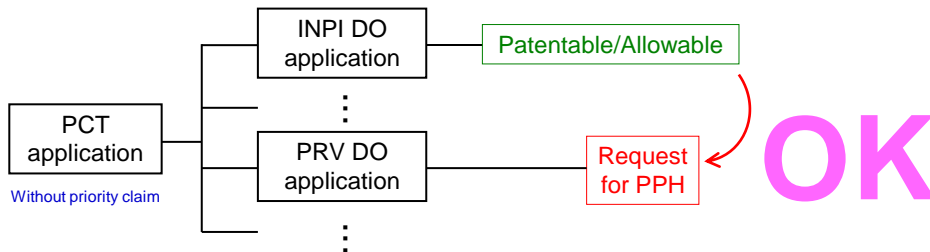


**J** A case meeting requirement (a) (I)  
 - PCT route -

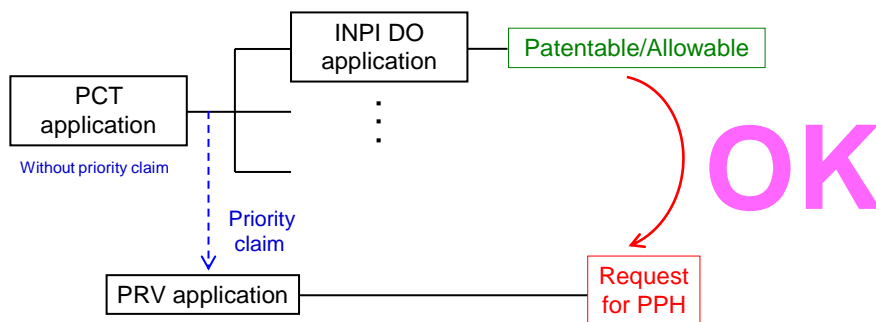




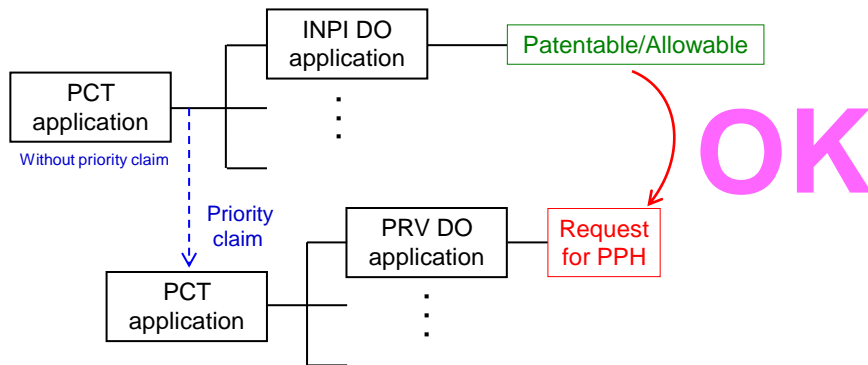
**K** A case meeting requirement (a) (IV)  
- Direct PCT route -



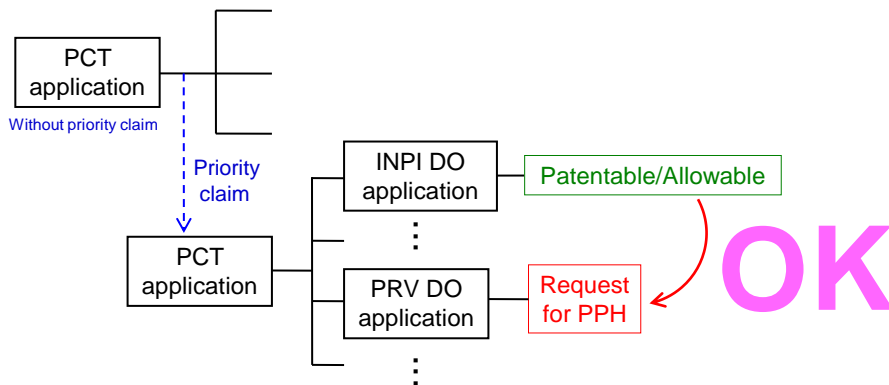
**L** A case meeting requirement (a) (III)  
- Direct PCT & Paris route -



**M** A case meeting requirement (a) (III)  
 - Direct PCT & PCT route -

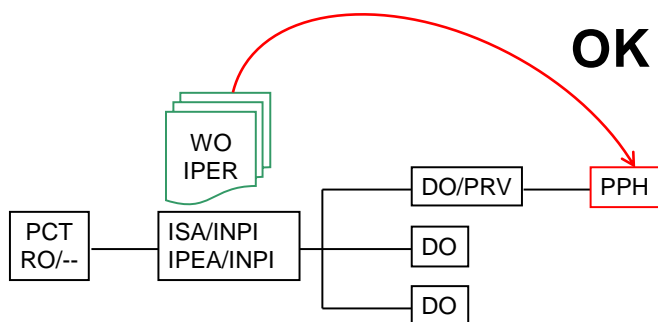


**N** A case meeting requirement (a) (III)  
 - Direct PCT & PCT route -



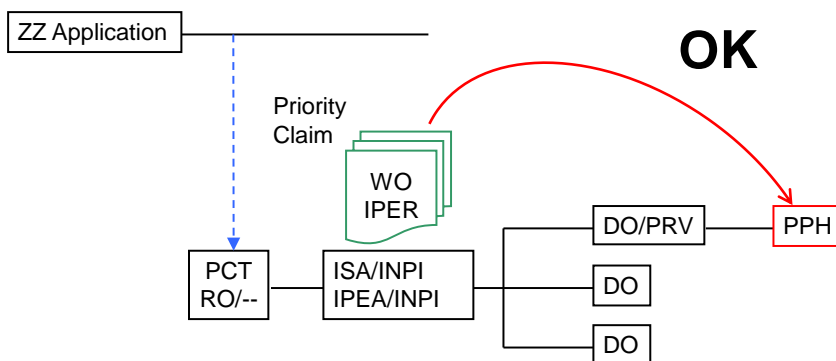
## Annex 3

**(A) The application is a national phase application of the corresponding international application.**



**(A') The application is a national phase application of the corresponding international application.**

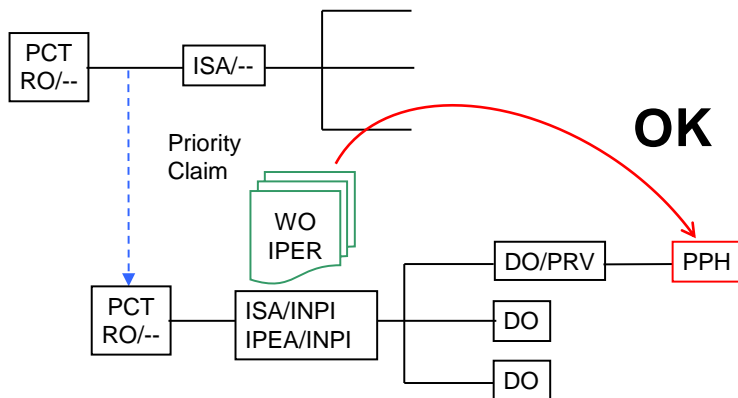
**(The corresponding international application claims priority from a national application.)**



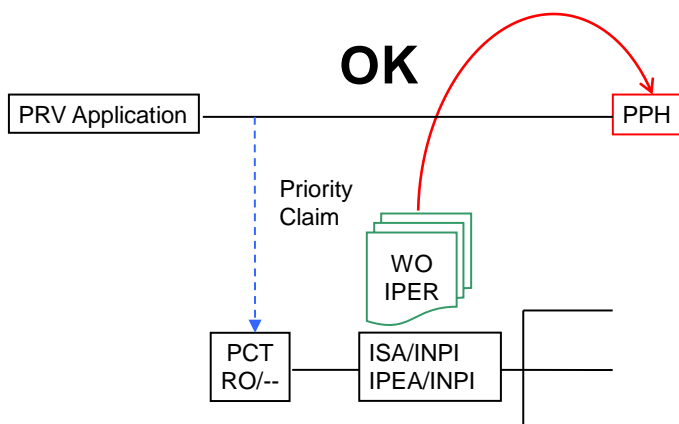
ZZ=any office

**(A'') The application is a national phase application of the corresponding international application.**

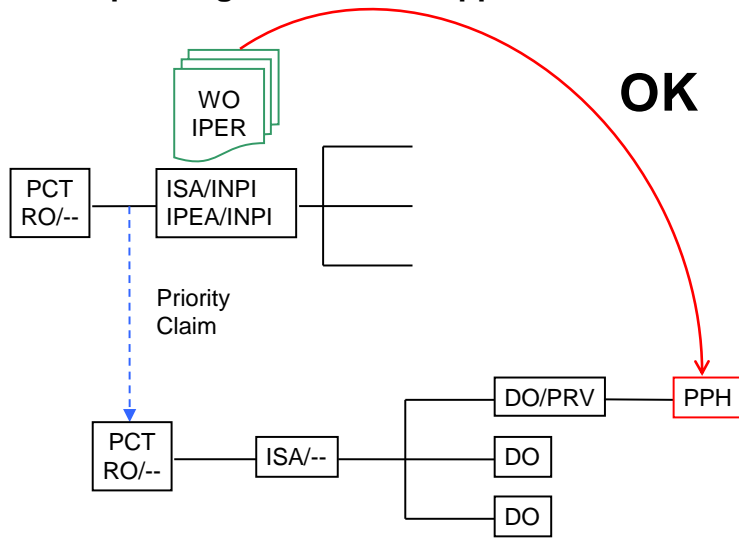
**(The corresponding international application claims priority from an international application.)**



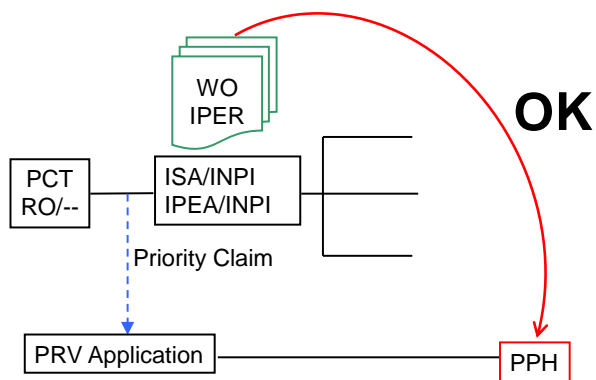
**(B) The application is a national application as a basis of the priority claim of the corresponding international application.**



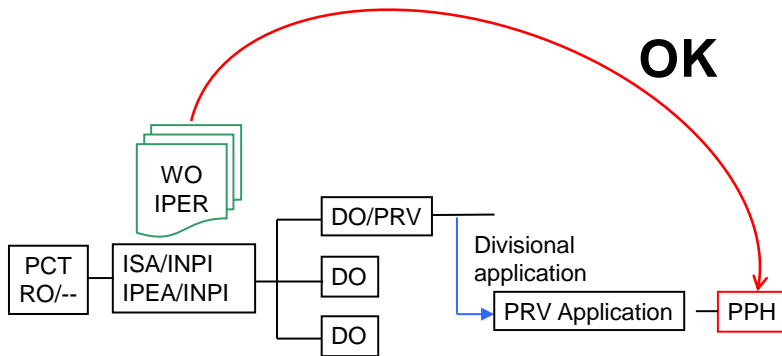
**(C) The application is a national phase application of an international application claiming priority from the corresponding international application.**



**(D) The application is a national application claiming foreign/domestic priority from the corresponding international application.**



**(E1) The application is a divisional application of an application which satisfies the requirement (A).**



**(E2) The application is an application claiming domestic priority from an application which satisfies the requirement (B).**

